

REMARKS

I. Status of Claims

Claims 321, 322, 325, 330, 334, 335, 337, 338 and 348-368 are currently pending. No claims have been amended herein.

II. Rejections Under 35 U.S.C. § 112

A. Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 355-368¹ have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. According to the Office, “there is no support in the specification for the structuring polymer species, which are ‘ethylenediamine/stearyl dimmer tallate copolymer or ethylenediamine/stearyl dimmer dilinoleate copolymer.’” (Office Action, p. 3.) The Office asserts that the description of Uniclear® in the specification of the present application and in the “International Cosmetic Ingredient Dictionary and Handbook,” which describes the two species of Unilclear®, is not adequate because the publication date of the latter is after the instant application’s filing date. (*Id.*) Applicants disagree.

Support for claims 355-368, reciting “ethylenediamine/stearyl dimmer tallate copolymer or ethylenediamine/stearyl dimmer dilinoleate copolymer,” can be found in the original specification on page 12. This paragraph recites Uniclear® polyamide

¹ The Office Action states that claims 355-369 are rejected under 35 U.S.C. § 112, first paragraph. However, Applicants note that the Office renumbered claims 362-369 as claims 361-368, and there is no longer a claim 369. Therefore, Applicants will treat this rejection as being directed to claims 355-368.

polymers and that these polymers “may be mixtures of copolymers derived from monomers of (i) C₃₆ diacids and (ii) ethylenediamine” This description readily conveys ethylenediamine/stearyl dimmer tallate and dilinoleate copolymers to one of ordinary skill in the art. See International Cosmetic Ingredient Dictionary and Handbook (“CTFA”), 657-58, 10th Ed. (2004) (previously submitted as Exhibit 1 to Applicants’ August 7, 2004, Amendment and Submission Under 35 U.S.C. § 1.114) (stating that ethylenediamine/stearyl dimmer dilinoleate copolymer is a copolymer of ethylenediamine and Dilinoleic Acid (q.v.) monomers, end-blocked with stearyl alcohol, and ethylenediamine/stearyl dimmer tallate copolymer is a copolymer of ethylenediamine and tall oil dimmer acid monomers, end-blocked with stearyl alcohol, both of which are known in the art by the trade name Uniclear®). Consequently, the specification reasonably conveys compositions and methods comprising including in the composition at least one structuring polymer chosen from ethylenediamine/stearyl dimmer tallate or dilinoleate copolymer.

Applicants note that, in co-pending Application Serial Nos. 09/937,314, 10/012,051, and 10/203,018, the Office requested that those Applicants provide some documentation showing that this species of polyamide polymer (*i.e.*, that known by the trade name Uniclear®) was known at the time these co-pending applications were filed. Accordingly, the Office was provided with a redacted version of confidential proprietary documents from the Assignee company showing that ethylenediamine/stearyl dimer tallate and dilinoleate copolymers were known as Uniclear® prior to the filing date of the applications. In the present case, the Examiner has indicated she would also require such documentation.

Applicants do not believe, however, that the requested confidential proprietary documents are either necessary or legally required. As discussed above, the specification describes the copolymers known as Uniclear® and necessarily establishes that this species of at least one heteropolymer was known at the time the application was filed. The previously supplied information from the CTFA further demonstrates that Uniclear® is the trade name for ethylenediamine/stearyl dimer tallate copolymer and ethylenediamine/stearyl dimer dilinoleate copolymer, which establishes that the at least one structuring polymer claimed was known at the time of filing. However, solely in an effort to advance prosecution of this case, Applicants attach herewith a copy of the redacted confidential proprietary documents as Exhibit 1. Therefore, as these claims are fully supported by the original specification and add no new matter, Applicants respectfully request that the Examiner withdraw this rejection.

B. Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 325, 330, 334, 337, 338, 349-354, 356-358, 360, 361, and 363-368 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim that which Applicants regard as their invention.

In determining whether the claims are sufficiently definite to comply with 35 U.S.C. § 112, second paragraph, the M.P.E.P. instructs that “[t]he essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” M.P.E.P. § 2173.02. Moreover, applicants are allowed “some latitude in the manner of expression and the aptness of terms” such that the Office’s inquiry is not to “whether

more suitable language or modes of expression are available,” but whether the language is definite in light of the content of the application, the teachings of the prior art, and the claim interpretation that may be given by one of ordinary skill in the art. *Id.* Applicants submit that the language in the rejected claims meets this threshold test for definiteness, as explained below.

First, the Office alleges that the phrase “treatment composition” lacks clarity, “as the specification does not define the scope for the expression ‘treatment.’” (Office Action at p. 3.) Applicants disagree, and point out that the phrase “treatment composition” is a term known and used in the cosmetic art, and is in fact clear from the specification. At page 3 of the specification, for example, Applicants state that “[t]he invention applies not only to make-up products . . . but also to body hygiene products such as deodorant sticks, and to care products and products for *treating* at least one keratinous material such as sunscreen (anti-sun) and after-sun products which may be in stick form and also nail products. (emphasis added)” Accordingly, one of skill in the art, reading the application, would understand the scope of the term “treatment composition,” in light of the disclosure regarding treating at least one keratinous material therein. Therefore, the phrase does not render the claims indefinite, and Applicants respectfully request the withdrawal of this reason for rejection.

Second, the Office alleges that the phrase “method for providing resistance to shear” also lacks clarity, “as the specification does not define the scope for the expression ‘resistance to shear.’” (Office Action at p. 3.) Applicants disagree, and note that the phrase “resistance to shear,” as used in claims 337, 353, 360, and 368, is also known and used in the art and is therefore not indefinite. For example, U.S. Patent No.

4,421,128, directed to "Compacted Greaseless Cosmetic Stick and Particularly Stick of Eye Shadow," states that the invention provides "a stick having resistance to shear stress sufficient to avoid any breakage during normal application of make-up." See col. 3, Ins. 21-26. It goes on to state that the stick of the invention has "both suitable strength and a suitable ability to rub off on the skin." *Id.* at col. 3, Ins. 46-49.

Moreover, the American Heritage College Dictionary (3rd Ed., 1993), at page 1254, defines shear as "[t]o become deformed by forces tending to produce shearing strain," and "[a]n applied force or system of forces that tends to produce a shearing strain." See Exhibit 2. Thus, one of skill in the art would understand that if a composition has increased resistance to shear, it will have an increased resistance to the forces which cause a shearing strain on the composition, thereby preventing such a deformation.

Accordingly, in light of the knowledge and use of the phrase "resistance to shear" in the art, as well as the commonly understood dictionary definition, Applicants submit that one of skill in the art would understand the phrase, and as such, it is not indefinite as the Office alleges. Applicants therefore respectfully request that the Examiner withdraw this reason for rejection.

Accordingly, the rejection under 35 U.S.C. § 112, second paragraph, is improper and should be withdrawn.

III. Comments Regarding Versamid

The Office has requested that Applicants provide the Office with the structure of the polymer Versamid[®] and state whether it is a species of formula I in the present

claims. The Office alleges that if Versamid[®] is a polymer of formula I, then the next Office Action issued will be non-final based upon U.S. Patent No. 6,423,324 anticipating the compositions claims under 35 U.S.C. § 102(e).

While Applicants have not been able to obtain the structure of the Versamid[®] polymer, Applicants direct the Office's attention to U.S. Patent Nos. 3,148,125 (see, e.g., column 2, lines 55-58) and 3,645,705 (see, e.g., column 2, lines 31-44), for information regarding this polyamide polymer. Versamid[®] is not believed to be a species of the polymer of formula I.

IV. Rejection under 35 U.S.C. § 103

The Office has maintained the rejection under 35 U.S.C. § 103 of claims 321, 322, 325, 330, 334, 335, 337, 338, and 348-354 as allegedly obvious over U.S. Patent No. 5,783,657 to Pavlin et al. ("Pavlin") in view of U.S. Patent No. 6,423,324 to Murphy et al. ("Murphy") and U.S. Patent No. 5,830,483 to Seidel et al. ("Seidel") for the reasons of record. Applicants respectfully traverse this rejection for at least the reasons of record and those set forth below.

According to the Office, Pavlin teaches the claimed polyamide polymers as gelling agents, and "the application of this gellant in various cosmetic personal care products." (Office Action at p. 4.) The Office relies on Murphy as teaching the combination of a polyamide resin and a cationic surfactant, and points to Seidel as teaching lauryl methyl gluceth-10 hydroxypropyl ammonium chloride, a specific oil-soluble surfactant of the claimed invention. (*Id.* at pp. 4-5.) From this, the Office concludes that one of ordinary skill in the art would have been "motivated to combine

the structuring polymer and substitute the oil soluble cationic surfactant of [Seidel] for the cationic surfactant in the compositions of [Murphy] with a reasonable expectation of success that the compositions would exhibit outstanding properties.” (*Id.* at p. 5.)

Applicants disagree.

In order to establish a *prima facie* case of obviousness, the Office must demonstrate, among other things, some suggestion or motivation to modify or combine reference teachings. M.P.E.P. § 2143. The threshold for establishing a motivation to combine is high, requiring “clear and particular” evidence of a motivation to combine. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617, 175 F.3d 994, 999 (Fed. Cir. 1999). As explained by the Federal Circuit, “[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *Id.*, at 1617, 175 F.3d at 999. This evidence must be explicitly set forth by the Office. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1433, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (emphasis added).

In the present case, the Office has not set forth any evidence of a motivation in the references to combine at least one oil-soluble cationic surfactant with the polyamide polymer of Pavlin; rather, the Office has merely provided conclusory statements that such motivation exists, stating that the motivation to make the proposed combination flows from the expectation that the resulting composition would exhibit “outstanding properties.” (See *id.* at p. 5.) Moreover, there simply is no “clear and particular” motivation to make the proposed combination of the cited art.

A. Pavlin

Pavlin relates to methods for preparing gelling agents that can be used in formulating transparent gels. (See *e.g.*, col. 1, Ins. 5-8, col. 2, Ins. 17-21, claim 1.) The gels of Pavlin are disclosed as being useful in a variety of compositions, including, for example, automobile wax/polish, furniture polish, metal cleaners/polishes, household cleaners, paint strippers, insecticides, fuels, toilet bowl rings, crayons, etc., in addition to cosmetics. (See, *e.g.*, Pavlin, col. 14, Ins. 37-53.) The only exemplified formulation embodying the invention of Pavlin is in the form of a candle. (See Example 25.) Pavlin does not contain any suggestion to formulate a cosmetic composition specifically containing at least one oil-soluble cationic surfactant.

Moreover, there is no teaching or suggestion in Pavlin that would have led the skilled artisan to add an oil-soluble cationic surfactant to the compositions therein to produce a cosmetic composition with “outstanding properties,” as the Office alleges. Pavlin teaches that its compositions do not exhibit syneresis, as the Office points out. (See July 16, 2003 Office Action, p. 4.) Therefore, it is illogical to assert that one of skill in the art would have been motivated to add an oil-soluble cationic surfactant to Pavlin with the expectation of reducing syneresis. One of skill in the art simply would not have been motivated to remedy a problem that the reference itself states does not exist in its compositions.

B. Murphy

The Office has not provided, and Murphy does not contain, any teaching that would have suggested specifically selecting cationic surfactants, let alone oil-soluble cationic surfactants, from the list of optional ingredients in Murphy for combination with

the gel formulations of Pavlin. Applicants do not assert that Murphy fails to teach or suggest at least one cationic surfactant at all, but rather, that one of ordinary skill in the art would not have been motivated to add such a cationic surfactant to the composition of Pavlin, in light of both the brief disclosure and the non-preferred nature of the cationic surfactant. While Murphy does teach the use of surfactants, it states that the surfactant is optional. (Col. 8, ln. 66 to col. 9, ln. 2.) Furthermore, the reference specifically states that non-ionic surfactants are preferred. (Col. 9, lns. 8-10.) Murphy provides over a column and a half of detailed text regarding the preferred non-ionic surfactants (col. 9, ln. 8 to col. 10, ln. 45), yet only summarily adds that cationic surfactants "can be used as the surfactant." (Col. 10, lns. 46-47.) In view of this disclosure, even assuming *arguendo* that one of ordinary skill in the art would have been motivated to add the optional surfactant of Murphy to the composition of Pavlin, he would have chosen a non-ionic surfactant, the preferred surfactant in Murphy.

Moreover, Murphy does not specifically mention oil-soluble cationic surfactants anywhere, but instead merely incorporates by reference a laundry list of more than 340 cationic surfactants, none of which are identified as to whether they are oil-soluble or water-soluble. (See McCutcheon's at 272-73.) It is unreasonable to conclude from this generic disclosure of non-preferred cationic surfactants that one of ordinary skill in the art would have been motivated to pick and choose specifically an oil-soluble cationic surfactant, incorporated by reference and buried amongst a disclosure of hundreds of other cationic surfactants.

Rather, one of ordinary skill in the art, when reading this disclosure as a whole, would select a nonionic surfactant based on the detailed and specific teachings and

would not pick a cationic surfactant that happens to be oil-soluble instead. To conclude otherwise is a failure read the disclosure as a whole, in favor of improperly picking and choosing from the disclosure. "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). Such picking and choosing is improper.

Furthermore, as explained above, both Pavlin and Murphy disclose that the compositions exhibit reduced or no syneresis; therefore, it is illogical to suggest that motivation for their combination lies in a suggestion in either reference of the desire to make the disclosed compositions resistant to syneresis. In fact, Murphy actually *teaches away from* this alleged motivation. At column 7, lines 1-20, Murphy discusses how the combination of the polyamide with the solvent actually shows *increased syneresis* in the absence of a specific gelling agent. Thus, one of skill in the art would not have been motivated to randomly pick and choose elements from the disclosure in Murphy in order to reduce syneresis in the composition of Pavlin, without also adding the specifically disclosed gelling agent, in light of this teaching.

Accordingly, the Office has failed to establish that one of ordinary skill would have been motivated to combine the cationic surfactant of Murphy with the composition of Pavlin, and further that the cationic surfactant would have been an oil-soluble cationic surfactant.

C. Seidel

Finally, Seidel does not provide motivation for the combination of the cited references. The Office has not provided, and Seidel does not contain, any teaching that

would have suggested specifically selecting lauryl methyl gluceth-10 hydroxypropyl ammonium chloride from the list of ionic emulsifiers disclosed therein for combination with the gel formulations of Pavlin. The Office asserts that one of skill in the art would have been motivated to make the proposed combination based on the desire to obtain a composition with "outstanding properties," such as modifying viscosity and achieving a rich appearance as disclosed in Seidel. (See July 16, 2003, Office Action, pp. 4-5.) However, Seidel attributes these properties to the inventive oil-in-water emulsion disclosed therein which contains an ionic emulsifier (see col. 4, lns. 45-52), not specifically to the presence of an oil-soluble cationic surfactant as the Office implies. Regardless, there no suggestion in Pavlin or Murphy of the need or desire to obtain a composition with these properties such that one of skill in the art would have been motivated to select the particular emulsifier for combination with those compositions even if it was attributed with producing such properties.

Accordingly, the Office has not sufficiently pointed to any specific teaching or suggestion in any of the references or in the knowledge of those skilled in the art that would have motivated the skilled artisan to combine them, as it must to satisfy its burden of establishing a case of obviousness. Therefore, the rejection is improper and should be withdrawn.

V. Copending Applications

In Table 2 of the Amendment filed on September 7, 2004, in this case, Applicants noted information regarding 37 copending applications, including the present application, and submitted copies of the pending claims as of that date for every case

identified therein. In the following Table 1, Applicants have noted four additional applications that have been filed, and enclose herewith in Exhibit 2 a copy of the copending claims for each additional case. Furthermore, Applicants submit herewith, also in Exhibit 2, copies of the currently pending claims from the following copending applications, which claims have been amended since September 7, 2004: 09/733,898, 09/733,899; 09/733,900; 09/618,066; 09/685,578; 10/203,018; 10/198,931; 09/937,314; 10/012,029; 10/012,051; 10/046,568; 10/182,830; 10/203,374; 10/312,083; and 10/787,440. Applicants submit these claims for the Office's convenience in evaluating any potential issues regarding statutory or obviousness-type double patenting.

Table 1.

Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date/ 371 (c) Date	Inventors	Title	Assignment Recorded (Reel, Frame, Date)	Publication, Date
05725.0932-01000	10/933,431	November 22, 2004	Véronique FERRARI	A TRANSFER-FREE COMPOSITION STRUCTURED IN RIGID FORM BY A POLYMER	Reel 012476, Frame 0507, on January 17, 2002	Not yet published
05725.1003-01000	10/933,430	November 22, 2004	Nathalie COLLIN	COSMETIC COMPOSITION COMPRISING A POLYMER BLEND	Reel 013142, Frame 0645, on August 1, 2002	Not yet published
05725.1004-01000	10/990,475	November 18, 2004	Nathalie COLLIN	USE OF A POLYMER FOR OBTAINING AN EXPRESS MAKE-UP OF KERATIN MATERIALS	Reel 012847, Frame 0285, on April 30, 2002	Not yet published
05725.1378-00000	11/019,382	December 23, 2004	Wei YU and Véronique FERRARI	COSMETIC COMPOSITION COMPRISING TWO DIFFERENT	Not yet recorded	Not yet published

Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date/ 371 (c) Date	Inventors	Title	Assignment Recorded (Reel, Frame, Date)	Publication, Date
				HETERO POLYMERS AND METHOD OF USING SAME		

VI. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.


Applicants note that the Office Action contains numerous characterizations of the invention and the cited art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: March 1, 2005

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Attachments: **Exhibit 1** Redacted Proprietary Documents
Exhibit 2 American Heritage College Dictionary (3rd Ed., 1993), p1254
Exhibit 3 Pending Claims in Copending Applications